

Amendment under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

REMARKS

The following remarks are made in response to the Final Office Action mailed December 20, 2005, in which claims 1-7, 10-24 and 30-32 are rejected. With this Response, amendments to claim 30 are presented. Claims 1-7, 10-24 and 30-32 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 103

Claims 1-5, 11-24 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of “American Interactive Media and Shopping.com Announce Strategic Marketing Agreement” (hereinafter AIME).

With respect to claim 1, the Office Action alleges that Tobin teaches providing members access to a co-branded Internet site including the graphical user interface of the Internet service provider accessed through the Internet service site and one or more links to the Internet shopping site of the retailer (referencing column 9, lines 5-50 and column 16, lines 62-66 of Tobin). The Office Action further alleges that while the specific embodiment includes the co-branding of Pathfinder and PC Flowers and Gifts, the invention includes embodiments that include an ISP (e.g. AOL) with a retailer. Finally, the Office Action alleges that Tobin teaches providing members of the co-branded Internet site with incentives to access and shop on the Internet shopping site of the retailer through the co-branded Internet site (see for example column 13, lines 25-30).

The Office Action acknowledges that Tobin does not specifically teach wherein providing members incentives comprises providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer. To overcome the acknowledged deficiencies of Tobin, the Office Action cites AIME as teaching a marketing agreement between American Interactive Media and Shopping.com (the co-branded ISP, referencing lines 1-4 of the Abstract of AIME) where customers allegedly accumulate “Maximizer Dollars” based on a quantity of merchandise purchased from Shopping.com and redeemable for discounted or free Internet access (referencing lines 10-13 of the full text of AIME). The Office Action concludes it would

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have been obvious to one of ordinary skill in the art at the time of the invention to modify the incentives as allegedly taught by Tobin to include discounted or free Internet service based on quantity of merchandise purchased as allegedly taught by AIME.

The Office Action provides additional comments on the rejections of dependent claims 2-5, 11-20 and 22-24. With regard to independent claim 31, the Office Action finds claim 31 to be substantially similar to claim 1 and therefore simply references the analysis for claim 1.

The rejection of claims 1-5, 11-24 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Tobin in view of AIME is respectfully traversed. Referring to Section 706.02 (j) of the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be met:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine reference teachings;
- (2) There must be reasonable expectation of success;
- (3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants submit that Tobin and AIME, individually and in combination, fail to teach or suggest all the limitations of independent claim 1. In particular, Tobin and AIME fail to teach or suggest *at least* “providing the members with a discount on subscription fees for access to the co-branded Internet site **based upon a quantity of merchandise purchased from the retailer.**” Tobin is acknowledged in the Final Office Action as failing to teach providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer. However, contrary to the characterization of AIME set forth in the Office Action, Applicants submit that **AIME is completely silent and provides absolutely no teaching or suggestion with regard to how “Maximizer Dollars” may be accumulated.** The teachings of AIME regarding discounted or free Internet access are limited to the single statement that “Benefits include no set up fees, and the ability to accumulate and redeem ‘Maximizer Dollars’ for discounted or free internet access.” There is clearly no teaching or suggestion in AIME that providing members with incentives comprises providing the members with a discount on subscription fees for access

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to the recited co-branded Internet site **based upon a quantity of merchandise purchased from the retailer**, or that the “Maximizer Dollars” are related in any way to a quantity of merchandise purchased from the retailer. Rather, it is only Applicants’ disclosure that teaches providing the members with a discount on subscription fees for access to the recited co-branded Internet site based upon a quantity of merchandise purchased from the retailer.

In view of the above, Applicants respectfully submit independent claim 1 is in allowable condition and request withdrawal of the rejection of claim 1 under 35 U.S.C. 103(a).

Dependent claims 2-5 and 11-24 depend directly or indirectly from independent claim 1, which is in allowable condition for at least the reasons set forth above. Accordingly, dependent claims 2-5 and 11-24 are also allowable over the art of record at least by reason of their dependency from claim 1, and withdrawal of the rejection of claims 2-5 and 11-24 under 35 U.S.C. 103(a) is respectfully requested.

With regard to independent claim 31, the remarks made with regard to independent claim 1 are equally applicable to claim 31. That is, Tobin and AIME fail to teach or suggest *at least* “providing the members with a discount on subscription fees for access to the co-branded Internet site **based upon a quantity of merchandise purchased from the retailer through the co-branded Internet site.**” In particular, **AIME is completely silent and provides absolutely no teaching or suggestion with regard to how “Maximizer Dollars” may be accumulated**, and it is only Applicants’ disclosure that provides such teaching. In view of the above, Applicants respectfully submit independent claim 31 is in allowable condition and request withdrawal of the rejection of claim 31 under 35 U.S.C. 103(a).

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of Staples.com.

With respect to claim 6, the Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 6 except wherein providing members incentives comprises providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printer. To overcome the acknowledged deficiencies of Tobin, the Office

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Action cites Staples.com as allegedly teaching providing advertising circulars on the Internet prior to distributing the printed versions (referencing the portion of the web page “Staples Specials for 2/29/00”). The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to include providing users with electronic versions of advertising circulars prior to distributing the printed versions as taught by Staples.com in order to drive traffic to the site.

Claim 6 depends directly from independent claim 1, which is in allowable condition for at least the reasons set forth above. Accordingly, dependent claim 6 is also allowable over the art of record at least by reason of its dependency from an allowable claim.

In addition, contrary to the characterization of Staples.com set forth in the Office Action, Applicants submit that **Staples.com fails to teach or suggest “providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed.”** There is no teaching or suggestion in Staples.com that the “Staples Specials for 2/29/00” are in any way related to printed advertising circular content. Even if the “Staples Specials for 2/29/00” was related to printed advertising circular content, there is no teaching that the information as presented on the Internet shopping site is available **before corresponding printed advertising circulars are distributed**, as is set forth in claim 6. Rather, it is only Applicants’ disclosure that teaches providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed. In view of the above, Applicants respectfully submit claim 6 is in allowable condition, and withdrawal of the rejection of claim 6 under 35 U.S.C. 103(a) is respectfully requested.

With respect to claim 7, the Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 7 except wherein providing members incentives comprises providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members. To overcome the acknowledged deficiencies of Tobin, the Office Action cites Staples.com as allegedly teaching publishing to registered users (members) “News and Hot Offers” before publishing

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to non-registered users (non-members) (referencing the portion of the web page “News and Hot Offers). The Office Action alleges that “News and Hot Product Offers” represents Applicants’ claimed “notice of store-based clearances, promotional events and/or special events.” The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Tobin to provide registered users with “News and Hot Product Offers” notices before non-registered users as taught by Staples.com. One of ordinary skill in the art would have allegedly been motivated to modify the references in order to entice customers to register.

Claim 7 depends directly from independent claim 1, which is in allowable condition for at least the reasons set forth above. Accordingly, dependent claim 7 is also allowable over the art of record at least by reason of its dependency from an allowable claim.

In addition, contrary to the characterization of Staples.com set forth in the Office Action, Applicants submit that **Staples.com fails to teach or suggest “providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members.”** There is no teaching or suggestion in Staples.com that the “News and Hot Product Offers” are provided to one class of users (i.e., members) before being provided to another class of users (i.e., non-members). The entering of an e-mail address simply allows a user to receive the “News and Hot Product Offers” in a different manner (i.e., via e-mail, rather than visiting the retailer’s web site). There is no teaching or suggestion that the e-mail recipients receive the news and product offers before the news and product offers are offered on the web site. Rather, it is only Applicants’ disclosure that teaches providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members. In view of the above, Applicants respectfully submit claim 7 is in allowable condition, and withdrawal of the rejection of claim 7 under 35 U.S.C. 103(a) is respectfully requested.

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Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME, as applied to claim 1 above, and further in view of “AOL” Wal-Mart next to team on Net service” by Sandeep Junnakar (hereinafter Junnakar).

The Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 10 except wherein the retailer operates retail stores and the method further comprises distributing software for the co-branded Internet site at the retail stores. To overcome the acknowledged deficiencies of Tobin, the Office Action cites Junnakar as allegedly teaching a co-branded website between ISP AOL and retailer Wal-Mart including the distribution of software at the retail establishment. The Office Action alleges that this is done in order to give those that have never been on the Net a sense of security. The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention modify the teachings of Tobin to include a retailer such as Wal-mart and to distribute software at the retail location as taught by Junnakar.

Claim 10 depends directly from independent claim 1, which is in allowable condition for at least the reasons set forth above. Accordingly, dependent claim 10 is also allowable over the art of record at least by reason of its dependency from an allowable claim, and withdrawal of the rejection of claim 10 under 35 U.S.C. 103(a) is respectfully requested.

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of Office Depot.com.

The Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 21 except including a link to an application for a proprietary credit card issued by the retailer. To overcome the acknowledged deficiencies of Tobin, the Office Action cites OfficeDepot.com as teaching including on a website a link to an Application for an Office Depot Credit card. The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the co-branded website of Tobin to include a like to an application for a proprietary credit card issued by the retailer as taught by OfficeDepot.com.

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Claim 21 depends directly from independent claim 1, which is in allowable condition for at least the reasons set forth above. Accordingly, dependent claim 21 is also allowable over the art of record at least by reason of its dependency from an allowable claim, and withdrawal of the rejection of claim 21 under 35 U.S.C. 103(a) is respectfully requested.

Independent claim 30 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME in further view of Junnakar, as applied to claim 10 above, and further in view of “IBM to sell Aptiva direct” by Joe Wilcox (hereinafter Wilcox).

The Office Action alleges that the combination of Tobin in view of AIME and in further view of Junnakar, as described above, teaches all the limitations of claim 30 except providing to members a link to news articles and a link to a page on the Internet shopping site offering for sale a product featured in the news article. To overcome the acknowledged deficiencies of Tobin, AIME and Junnakar, the Office Action cites Wilcox as evidence that prior to Applicants’ invention it was old and well known to include within news articles links to product pages that sell the products featured in the article. The Office Action further alleges that Tobin teaches links to news articles (see for example Figure 11A, “Latest News”). The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the news articles of Tobin to include links to product pages to buy the products featured in the articles as taught by Wilcox.

Independent claim 30 has been amended to specify that the method includes “providing to members clusters of links having related content, the clusters of links including a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.” Applicants submit that Tobin in view of AIME in further view of Junnakar, and further in view of Wilcox, individually and in combination, fail to teach or suggest all the limitations of independent claim 1. In particular, the cited references fail to teach or suggest *at least* “providing to **members clusters of links having related content, the clusters of links including a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.**”

Although Tobin teaches links to news articles (e.g., as in Fig. 11A), Tobin fails to teach or suggest **clusters of links having related content**, the clusters of links **including a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article**. Rather, the clusters of links in Tobin are links having *disparate* content (e.g., “Money Personal Finance”; “Sports”; “Techwatch” as shown in Fig. 11A of Tobin). Wilcox teaches news articles having links to product pages that sell the products featured in the article. However, Wilcox fails to teach or suggest **clusters of links having related content**, the clusters of links **including a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article**. In Wilcox, a user can only access the link to a page offering for sale a product featured in the news article by first accessing the news article. That is, Wilcox teaches “serial” access to the links, as opposed to the clustered links as described and claimed in the present application. AIME and Junnakar both fail to remedy the deficiencies of Tobin and Wilcox, as neither AIME nor Junnakar teach or suggest “clusters of links having related content, the clusters of links including a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.”

In view of the above, Applicants respectfully submit amended independent claim 30 is in allowable condition and request withdrawal of the rejection of claim 30 under 35 U.S.C. 103(a).

Claim 32 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME as applied to claim 1 above, and further in view of “Snafu prompts Microsoft to suspend some PC rebates” by Michael Kannellos (hereinafter Kannellos).

The Office Action alleges that the combination of Tobin in view of AIME, as described above, teaches all the limitations of claim 32 except providing members with a discount on merchandise purchased wherein the rate of merchandise discount and period of time of which the discount is available varies on the basis of the length of member’s subscription to the Internet service provider. To overcome the acknowledged deficiencies of Tobin, the Office Action cites Kannellos as allegedly teaching that at the time of the Applicants’ invention it was well known for Internet service providers to give customers

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discounts on products at affiliated retail stores based on the length of the customer's subscription to the Internet service provider. In the specific case of Kannellos, customers that agreed to a 3 year subscription were given a \$400 rebate to an affiliated retail store. The Office Action concludes it would have been obvious to one of ordinary skill in the art at the time of the invention modify the teachings of Tobin to include providing a discount at PC Flowers (affiliated retailer) based on a length of subscription to an ISP as taught by Kannellos.

Applicants submit that Tobin, AIME and Kannellos, individually and in combination, fail to teach or suggest all the limitations of independent claim 32. In particular, Tobin, AIME and Kannellos fail to teach or suggest *at least* "providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer, and further providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider."

As discussed above with regard to independent claim 1, Tobin and AIME fail to teach or suggest "providing the members with a discount on subscription fees for access to the co-branded Internet site based upon a quantity of merchandise purchased from the retailer." The remarks made with regard to independent claim 1 are equally applicable to independent claim 32. That is, as acknowledged in the Final Office Action, Tobin fails to teach providing members with a discount on subscription fees for access to the co-branded Internet site based upon quantity of merchandise purchased from the retailer. In addition, there is no teaching or suggestion in AIME that providing members with incentives comprises providing the members with a discount on subscription fees for access to the recited co-branded Internet site based upon a quantity of merchandise purchased from the retailer.

The Office Action acknowledges that Tobin and AIME fail to teach or suggest "providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider," and cites Kannellos as

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remedying this deficiency. Contrary to the characterization of Kannellos set forth in the Office Action, Kannellos does not teach or suggest a rate of the merchandise discount varies on the basis of the length of a member's subscription, and further does not teach or suggest a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription. Rather, **the rate of merchandise discount in Kannellos is dependent upon the product purchased** (i.e., buy a three year subscription and receive a \$400 discount), **and does not vary on the basis of the length of a member's subscription** to the Internet service provider. Further, there is no teaching or suggestion that the rate of merchandise discount varies even on the basis of the product purchased, much less the length of a member's subscription. Finally, Kannellos makes no teaching regarding *how long* the discount is available. The only mention of a time period in Kannellos is with respect to the product purchased (i.e., a three year subscription). Thus, Kannellos cannot be said to teach or suggest that the period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription. Rather, it is only Applicants' disclosure that teaches "providing the members with a discount on merchandise purchased on the Internet shopping site accessed through the co-branded Internet site, wherein a rate of the merchandise discount and a period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription to the Internet service provider"

In view of the above, Applicants respectfully submit independent claim 32 is in allowable condition and request withdrawal of the rejection of claim 32 under 35 U.S.C. 103(a).

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CONCLUSION

Applicants respectfully request admission of this Amendment under 37 C.F.R. 1.116. For at least the reasons provided above, Applicants believe claims 1-7, 10-24 and 30-32 are in allowable condition, and Notice to that effect is respectfully requested.

The Examiner is invited to contact the Applicants' representative at the below-listed telephone numbers to facilitate prosecution of this application.


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Respectfully submitted,



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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of March, 2006.



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